

REMARKS

This Reply is in response to the Office Action mailed on October 20, 2004 in which Claims 64-71 were allowed; in which Claims 62 and 63 were objected to; and in which Claims 29, 31-55 and 58-61 were rejected. With this response, Claim 33 is cancelled and Claims 29, 31 and 58 are amended. Claims 29, 31-32, 34-55 and 58-71 are presented for reconsideration and allowance.

I. Claim Rejection.

Page 2 of the Office Action objected to Claim 31 noting an informality. Claim 31 has been amended to correctly depend from Claim 29. Accordingly, withdrawal of the objection is requested.

II. Rejection of Claims 29, 31-38, 41-44, 48-55 and 58-61 Under 35 U.S.C. § 103 Based Upon Silverbrook, Frechtman and Marinoff.

Page 2 of the Office Action rejected Claims 29, 31-38, 41-44, 48-55 and 58-61 under 35 U.S.C. § 103(a) as being unpatentable over Silverbrook et al., U.S. Patent No. 6,290,349, in view of Frechtman, U.S. Patent No. 3,990,670 and Marinoff, U.S. Patent No. 4,207,578. Claim 33 is cancelled. Claims 29, 31-32, 34-38, 41-44, 48-55 and 58-61, as amended, overcome the rejection based upon Silverbrook, Frechtman and Marinoff.

Independent Claims 29 and 58 each recite a media processing device which includes a media processing engine having a media input along an external face of the device and a media output opposite the external input. Each of Claims 29 and 58 further recite that the media input is configured to receive the media while the media is in a vertical orientation. Similarly, independent Claim 59 recites a method for processing media in which media is fed through a media input along an external face of the device to an engine while the media is substantially vertical.

Neither Silverbrook, Frechtman nor Marinoff disclose or suggest a media processing device or a method for processing media wherein media is fed through a media input along an external face of the device to the engine while the media is

substantially vertical and is discharged from an external media output opposite the media input. The Office Action acknowledges that Silverbrook fails to disclose feeding media through an external media input while the media is substantially vertical and discharging media out in external media output opposite the input. (See Office Action, p. 6 - discussing Claim 59). As a result, in its rejection of Claim 59 and Claim 33, which has now been cancelled with its limitations incorporated into Claim 29, the Examiner attempts to additionally rely upon Marinoff. With respect to Marinoff, the Office Action asserts that Marinoff discloses an "an outer-external paper supply housing". (Office Action, p. 7). The Office Action further asserts that "The combination naturally suggests: . . . {claim 59} supporting a media processing engine along a vertical surface." (Office Action, p. 8 – discussing Claim 59).

However, Marinoff fails to satisfy the acknowledged deficiency of Silverbrook. First, nowhere does Marinoff disclose the location or whereabouts of its external media input. In fact, the external media input of Marinoff may indeed be horizontal bays into which trays 33 and 41 are loaded. Secondly, even assuming, arguendo, that trays 33 and 41 would be external to a media input, Marinoff does not disclose a media input that receives media while the media is in a vertical orientation. In contrast, supply tray 33 is in a horizontal orientation such that its media 32 is also in a horizontal orientation when being received. Nowhere does Marinoff suggest that its tray 33 may be reoriented to a vertical orientation. In fact, such a modification to Marinoff would require a substantial redesign of Marinoff. Frechtman, which discloses a toilet paper holder, clearly does not disclose an external media input configured to receive media while the media is in a vertical orientation.

Moreover, even assuming, arguendo, that Marinoff did disclose an external media input configured to receive media while the media is in a vertical orientation, it would not be obvious to modify Silverbrook based on Marinoff because (1) no teaching or suggestion exists for such a modification and because (2) it would destroy the intended operation of both Silverbrook and Marinoff.

First, no teaching or suggestion exists for modifying Silverbrook in view of Marinoff. In attempting to combine the teachings of Silverbrook and Marinoff, the

Office Action asserts that “The motivation for the skilled artisan in doing so is to gain the benefit of being able to quickly feed sheets to the media processing engine without constantly taking out the paper supply cartridge.” (Office Action, p. 9). However, as noted above, Marinoff does not disclose where its housing is located or where an external media input is provided. In fact, supply tray 33 may well need to be constantly taken out for supplying media to the device. Thus, Marinoff is no different than Silverbrook and no motivation would exist for modifying Silverbrook based upon Marinoff. Neither Silverbrook nor Marinoff provide any other suggestion or benefit from modifying Silverbrook based upon Marinoff or any hint of even how Silverbrook might be modified based upon Marinoff. Instead, the Office Action’s motivation for modifying Silverbrook based upon Marinoff is actually based upon Applicant’s own disclosure.

Second, it would not be obvious to modify Silverbrook based upon Marinoff because such a combination would destroy the intended function of both Silverbrook and Marinoff. (See MPEP 2143 THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE; THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE). One of the main objectives of Marinoff appears to be a catch for receiving ink drops from a non-contact jet drop printhead (see col. 3, lines 10-15). To this end, Marinoff causes a sheet from stack 32 in supply tray 33 to wrap about drum 14 which underlies jet drop printhead 18 and which includes a receiving aperture or catch 16. To catch the ink, Marinoff requires that the media do an about-turn about drum 12. As a result, supply tray 33 and receiving tray 41 extend next to one another. To alternatively input media through an external media input and output media through an external media output opposite the media input would prevent the media from being turned about a drum and would change the intended principle of operation of Marinoff.

Moreover, it would not be obvious to modify Silverbrook in view of Marinoff since the hypothetical modification proposed in the Office Action would destroy the intended purpose of Silverbrook. One of the main objectives of Silverbrook appears

to be supporting a printer along a wall in a compact arrangement. To modify Silverbrook to replace its internal paper supply with supply tray 33, which is horizontal, would seemingly prevent Silverbrook from being compactly arranged along a vertical wall. Moreover, to enable the media transfer mechanism of Silverbrook to be able to pick a sheet of media from a horizontal supply tray would appear to require a complete redesign of Silverbrook. Once again, neither Silverbrook nor Marinoff disclose or suggest an external media input that receives media while the media is in a vertical orientation. Thus, Claims 29, 58 and 59, as amended, overcome the rejection based upon Silverbrook, Marinoff and Frechtman. Claims 31-32, 34-38, 41-44, 48-55 and 58-61 depend from independent Claims 29, 58 and 59 and overcome the rejection for the same reasons.

III. Rejection of Claims 39-40 Under 35 U.S.C. § 103 Based Upon Silverbrook, Frechtman and Marshall.

Page 9 of the Office Action rejected Claims 39 and 40 under 35 U.S.C. § 103(a) as being unpatentable over Silverbrook et al., U.S. Patent No. 6,290,349, in view of Frechtman, U.S. Patent No. 3,990,670, and further in view of Marshall, Jr., U.S. Patent No. 4,074,872. Claims 39 and 40 depend from Claim 29 and overcome the rejection for the same reasons discussed above with respect to Claim 29.

IV. Rejection of Claims 45-46 Under 35 U.S.C. § 103 Based Upon Silverbrook, Frechtman and Khormaeae.

Page 10 of the Office Action rejected Claims 45-46 under 35 U.S.C. § 103 as being unpatentable over Silverbrook et al., U.S. Patent No. 6,290,349, in view of Frechtman, U.S. Patent No. 3,990,670, and further in view of Khormaeae, U.S. Patent No. 5,397,192. Claims 45 and 46 depend from Claim 29 and overcome the rejection for the same reasons discussed above with respect to Claim 29.

V. Rejection of Claim 47 Under 35 U.S.C. § 103 Based Upon Silverbrook, Frechtman and Kikuchi.

Page 11 of the Office Action rejected Claim 47 under 35 U.S.C. § 103(a) as being unpatentable over Silverbrook et al., U.S. Patent No. 6,290,349, in view of Frechtman, U.S. Patent No. 3,990,670, and further in view of Kikuchi, U.S. Patent No. 5,929,894. Claim 47 depends from Claim 29 and overcomes the rejection for the same reasons discussed above with respect to Claim 29.

VI. Conclusion.

After amending the claims as set forth above, claims 29, 31-32, 34-55 and 58-71 are now pending in this application.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025.

Respectfully submitted,

Date Jan. 13, 2005

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